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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,659	06/28/2001	Hiroki Moriyama	14731	6961

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EXAMINER

JASTRZAB, KRISANNE MARIE

ART UNIT PAPER NUMBER

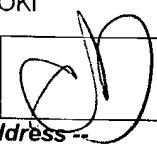
1744

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No. 09/894,659	Applicant(s) MORIYAMA, HIROKI
Examiner Krisanne Jastrzab	Art Unit 1744



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.
- 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-15 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    - 1.  Certified copies of the priority documents have been received.
    - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/28/01.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

The abstract of the disclosure is objected to because of the inclusion of legal phraseology such as "comprising". Correction is required. See MPEP § 608.01(b).

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the use of "high" and "thin" are found to be vague and indefinite because it is unclear as to what would actually constitute "high" or "thin". Also, "the endoscope" lacks proper antecedent basis because such basis

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cannot be provided by a recitation in the preamble of an apparatus claim.

Finally, "local pressing forces" is found to be vague and indefinite because it is unclear as to what would constitute such forces.

With respect to claim 3, "the peripheral elements" lacks proper antecedent basis.

With respect to claim 4, this claim is found to be vague and indefinite because it is unclear as to what actual structure is being set forth in this claim.

With respect to claim 5, this claim is found to be vague and indefinite. It is unclear as to what "thereof" is referring to.

With respect to claim 6, "the operating part" lacks proper antecedent basis.

With respect to claim 8, this claim is found to be vague and indefinite because it refers to activity of the "restricting member" which was not set forth in claim 7. Additionally, the reference to "the vessel" in the body of the claim is improper because the "vessel" cannot be used to define itself.

With respect to claim 9, this claim is found to be vague and indefinite because it attempts to improperly define the structure by itself with the reference to "the vessel" in the body of the claim. Also, "the pressure force" lacks proper antecedent basis because it was previously referred to as the "pressing force". The use of "high" is found to be vague and indefinite for the same reason as cited above.

With respect to claim 13, the use of "smooth" is found to be vague and indefinite because it is unclear as to what would constitute "smooth".

With respect to claim 14, this claim is found to be vague and indefinite because the language recited does not make sense and the Examiner cannot determine what structure the Applicant is attempting to claim.

With respect to claim 15, the use of "gentle" is found to be vague and indefinite because it is unclear as to what would constitute "gentle". This claim is further found to be vague and indefinite because it is improperly attempting to further limit a structural element that has not been previously positively claimed, namely the insertion part of the endoscope.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 7 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dane et al., U.S. patent No. 5,843,387.

Dane et al., teach an apparatus for containing an endoscope for steam sterilization, having a resilient force preventing means which surround a portion of the endoscope to support and protect it.

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Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillebrenner et al., U.S. patent No. 5,534,221.

Hillebrenner et al., set forth a container for endoscope sterilization wherein both a tray and lid are provided, with each having a recessed means for predetermined placement and protection of the endoscope with means to prevent different areas of the endoscope to touch during treatment. See column 2, lines 40-45 and 55-62, column 3, lines 1-6, and 10-20 and 29-36, and column 6, lines 10-60, column 7, 64-68, and finally column 10, lines 60-65.

The above rejections are applied in view of the 112, rejection set forth above.

### ***Double Patenting***

Claims 1-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/919190. Although the conflicting claims are not identical, they are not patentably distinct from each other because based on a reading of the claims in light of the 112, 2nd paragraph and as such, they seem to be claiming the same subject matter with the instant application differing only in what appears to be a lid sealing mean in this instant application which does not provide patentable distinction therebetween as such means are well known and expected in the art of sterilization containers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

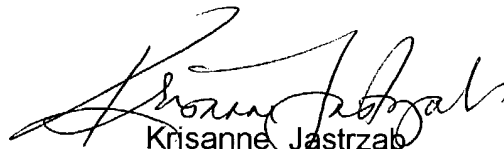
### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J. Warden can be reached on 571-272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Krisanne Jastrzab  
Primary Examiner  
Art Unit 1744

August 9, 2004